

REMARKS

Claims 1-6, 8-14 and 16-19 are pending in this application. Claims 9 and 17 have been amended. No new matter has been introduced. The amendments to claims 9 and 17 obviate the drawing rejection (based on the ground the drawings donot illustrate an anchor body with a constant outer diameter), but do not raise any new issues and should be entered.

Regarding the objection of the drawings (as failing to illustrate the second suture threaded through the suture eyelet), Applicants submit that a replacement sheet for Figure 6 was submitted with the October 8, 2008 Amendment. The replacement sheet for Figure 6 illustrates a second suture strand 300 pre-threaded through the eyelet of the first suture strand 8. Applicants further submit that the specification and the drawings do not describe and illustrate two suture strands passed through an eyelet, but rather one suture strand passed through an eyelet of another suture strand.

Claims 1-6, 8-14 and 16-19 are rejected under 35 U.S.C. § 112, first paragraph, on the ground that the second suture threaded through the eyelet is not shown in Figure 6 and on the ground that the specification and/or drawings do not support two sutures passing through the eyelet. This rejection is respectfully traversed. Revised Figure 6 (submitted with the October 8, 2008 Amendment) illustrates one suture strand 300 (a second suture strand 300) pre-threaded through the eyelet 20 formed by another suture strand 8 (a first suture strand 8). In accordance with the drawings, the specification also describes only one suture strand passed through the eyelet of another suture strand. The “second suture” recited in the claims is the one and only suture that passes through the suture eyelet or suture loop (which is formed of the “first suture”). Applicants submit that all pending claims are in full compliance with 35 U.S.C. § 112.

Claims 1-6, 8, 11-13, 16 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grafton et al. (U.S. Patent No. 5,964,783) (“Grafton”) in view of Greenfield (U.S. Patent No. 5,584,835). This rejection is respectfully traversed.

Grafton and Greenfield, considered alone or in combination, do not disclose or suggest all limitations of claims 1, 5 and 11. Grafton specifically teaches against the claimed invention and, thus, Grafton cannot disclose or suggest all limitations of the claimed invention. In the “background of the Invention” section of the present application, the inventors describe Grafton in ¶[0005] as follows:

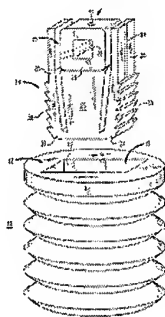
U.S. Pat. No. 5,964,783 to Grafton et al. . . . discloses a threaded bioabsorbable suture anchor provided with a loop of suture that is insert-molded directly into the suture anchor during manufacturing. The proximal end of the suture anchor body of the '783 patent is provided with a non-threaded hexagonal drive head. The insert-molded suture preferably extends through the entire length of the suture anchor body and exits through the drive head at the proximal end of the anchor to form a loop of suture external to the suture anchor. In this manner, the suture forming the loop is secured effectively to the threaded suture anchor and is prevented from becoming detached from the anchor. However, because the suture anchor of '783 patent is provided with the non-threaded hexagonal head, the threads of the threaded anchor body do not reach the top of the cortical bone when the suture anchor is installed. Thus, the threaded anchor body tends to move up to the bone surface by at least a distance equal to the length of the non-threaded hexagonal head, such that the drive head may become proud to the surface. Moreover, the suture of the eyelet, which is disposed outside the suture anchor in back of the drive head, may abrade the adjacent tissue.

To overcome the disadvantages of Grafton, the inventors state in the specification that a “need exists for a bioabsorbable suture anchor having a suture loop that does not extend beyond the drive head and does not abrade tissue” (¶[0006]) proposing, instead (as the invention), an anchor with a suture eyelet (suture loop) disposed completely within the anchor body. Thus, for at least the reasons above, Grafton cannot disclose or suggest all limitations of the claimed invention and one

skilled in the art would not have been motivated to consider Grafton (much less to combine Grafton with other prior art references) to arrive at the claimed invention.

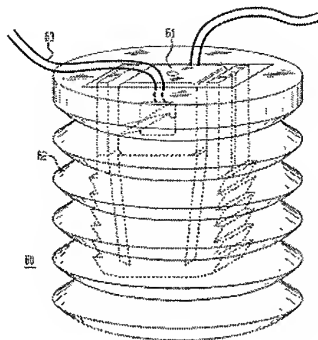
Clearly, Grafton does not disclose or suggest “a suture eyelet . . . disposed completely within the anchor body,” or a “suture loop disposed completely within the drive socket,” as claims 1, 5 and 11 recite. Loop 11 of Grafton ‘783 (which would arguably correspond to the “suture eyelet” or “suture loop” of the claimed invention) is located outside the hexagonal drive head 10 and outside the body 4, and not “completely within the anchor body,” as in the claimed invention.

Greenfield fails to address the deficiencies of Grafton. Greenfield is silent about a “suture eyelet” or “suture loop” provided “completely within the anchor body,” as in the claimed invention. Greenfield teaches a two-part device for suturing soft tissue to bone and none of the limitations of the claimed invention.



In the Office Action dated February 17, 2010, the examiner asserts that “Greenfield teaches the suture eyelet being disposed completely within the anchor body” (Office Action at 4). Applicants disagree. Figure 5 of Greenfield (reproduced below) does not illustrate an eyelet of a suture strand that is insert-molded within the anchor body.

FIG. 5



As detailed by Greenfield (and as shown in Figure 5 above), Greenfield simply teaches “sutures 63 . . . held by friction” when suture anchor 61 fully engages bone anchor 62 (col. 9, ll. 40-44). Greenfield does not disclose or suggest, however, a bioabsorbable suture anchor with a suture strand that is insert-molded into the bioabsorbable in the form of an eyelet disposed completely within the bioabsorbable anchor body.

Applicants also submit that a person of ordinary skill in the art would also not have been motivated to combine Grafton with Greenfield. First, Grafton teaches against the claimed invention and, thus, there is no motivation for one skilled in the art to consider Grafton (or to combine Grafton with any other reference) to arrive at the claimed invention.

Second, one skilled in the art would not have been motivated to combine the single piece, insert-molded suture anchor of Grafton (provided with a suture loop which extends outside the body anchor) with Greenfield (which teaches two separate structures – a suture anchor 11 and a bone anchor 12 – that are designed to lock into each other). Picking and choosing elements of a reference is simply not the standard for obviousness.

Third, Applicants submit that “[T]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.” MPEP § 706.02(j). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner *must present*

a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Id.* (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (B.P.A.I. 1985) (emphasis added). In the present case, Grafton and Greenfield do not expressly or impliedly suggest the claimed invention, and the Examiner has failed to present a clear and convincing line of reasoning regarding the obviousness of the claimed invention in view of the cited prior art references.

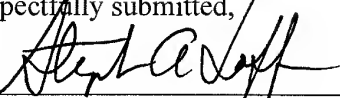
Applicants further submit that it is improper to use Applicant’s own disclosure as a roadmap for modifying references. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and *not based on applicant’s disclosure*.” *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); MPEP § 706.02(j) (emphasis added). In the present case, the problem of countersinking to be solved by Grafton does not pertain to the fixation of tissue to cancellous bone of Greenfield and, thus, there would be no motivation -- in either Grafton or Greenfield -- to combine these references. Reliance upon Applicant’s own disclosure to modify the reference, i.e., to combine Grafton with Greenfield to arrive at the present invention, is impermissible. For at least these reasons, the Office Action fails to establish a *prima facie* case of obviousness and withdrawal of the rejection of claims 1-6, 8, 11-13, 16 and 19 is respectfully requested.

Applicants respectfully traverse the obviousness-type double patenting rejection of claims 1-6, 8-14, and 16-19 over claims 1-4 of U.S. Patent 7,226,469 and claims 1-10 of U.S. Patent No. 5,964,783. These prior patents claim a suture anchor with an insert-molded suture loop, but do not claim an anchor with an insert molded suture loop or suture eyelet which is “disposed completely within the anchor body” as presently claimed. Accordingly, for the same reasons as discussed about with respect to the prior art rejection under § 103 based on U.S. Patent No. 5,964,784, the claims of the present application are deemed to be patentably distinct and non-obvious over U.S. Patent Nos. 7,226,469 and 5,964,783, and withdrawal of the double patenting rejection is respectfully requested.

Allowance of all pending claims is solicited.

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Respectfully submitted,

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